

In claim 9, please delete "claim 8" and insert ---claim 2---

Remarks

Claims 15, 16, 18-20, 22-24, 26, 27, 29-31, 33-35, 37, 38, 40-42, 44-46, 48-52, 54-56, 58-64, 66 and 67 drawn to a non-elected invention have been withdrawn from consideration by the Examiner. Claims 1-7, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29-31, 33-35, 37, 38, 40-42, 44-46, 48-52, 54-56, 58-64, 66 and 67 remain in the case upon entry of this amendment. Entry of this amendment, and reconsideration and reexamination of the above-identified application are respectfully requested.

Note, claim 8 was canceled by preliminary amendment.

1. Information Disclosure Statement:

Applicants have not received any indication from the PTO that the Information Disclosure Statement (IDS) filed on March 31, 1999 (postcard return receipt date stamped April 2, 1999) has been considered by the Examiner. During a telephone call to the front desk for the 1600/2900 Technology Center on September 24, 1999 it was indicated that the IDS was entered in to the case on April 2, 1999 (according to the PTO PALM Intranet System).

Applicants respectfully request consideration of the information contained in said IDS if not previously considered, and request an indication that each reference was considered by returning a copy of the initialed and dated PTO 1449 form.

2. Restriction Requirement:

The PTO has maintained the Restriction Requirement in Paper No. 7. However the PTO has failed to address Applicants' arguments traversing the requirement (see Applicants' Election filed May 18, 1999 (Paper No. 10). Applicants maintain their traversal of the Restriction Requirement for reasons of record.

Applicants most respectfully request reconsideration and withdrawal of the Restriction Requirement in the next office action.

Note, the PTO in the Office Action of June 28, 1999 has failed to consider and examine on the merits **claim 7** which is drawn to Applicants' elected invention.

Applicants also traverse the withdrawal from consideration of **claims 58, 59 and 62**, which are drawn to Applicants elected invention.

Applicants have not been accorded a complete and full examination of the elected invention and claims reading thereon. Reconsideration and re-examination respectfully requested.

3. Amendments to the claims:

Claim 6 has been amended so as to provide antecedent basis for the "solvent" term in the claim. Support for the amendment can be found at least in the claims as originally filed and in the specification at page 4, line 6.

Claim 9 has been amended to correct the claim dependency. Note, claim 8 was previously canceled.

4. Rejections under § 112(2):

Applicants traverse the rejection of claims 6 and 8 under 35 U.S.C. § 112, second paragraph for being indefinite. Reconsideration and withdrawal of the §112(2) rejection are respectfully requested.

The rejection of claim 6, for failure to provide antecedent basis for the "solvent" feature is now moot in view of the instant amendment to the claims.

As indicated above claim 8 has been previously canceled by the Preliminary Amendment filed on June 16, 1998, and therefore the rejection of the claim is moot. Note, however, claim 9 has been amended by the instant reply to address a claim dependency problem.

5. Rejection under § 135(b):

Applicants traverse the rejection of claims 1-6, 8, 9, 12 and 13 under 35 U.S.C. § 135(b) as not being made prior to one year from the date of which U.S. Patent No. 5,679,796 was granted. Reconsideration and withdrawal of the §102 rejection are respectfully requested.

The statute here involved, section 135(b), reads as follows:

Section 135 Interferences

...

(b) A claim which is the same as, or of *the same or substantially the same subject matter* as, a claim of an issued patent may not be made in any application unless such a *claim is made prior to one year* from the date on which the patent was granted.
[Emphasis added.]

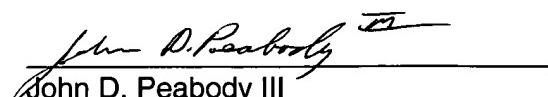
It is clear from recent case law that § 135 (b) may be used, in accordance with its literal terms, as a basis for *ex parte* rejections. See In re McGrew, 43 USPQ2d 1632, (Fed. Cir. 1997). Nevertheless, Applicants most respectfully submit that the rejection is improper for the following reasons:

- 1) The PTO has neglected to carry its burden for establishing a *prima facie* case as to why 35 U.S.C. § 135 should operate in the instant case to effect a statutory bar, estoppel or loss of right! First, the Office Action fails to set forth the requisite findings of fact to establish that the Applicants claimed invention is the "same or substantially same subject matter" as claimed by US 5,679,796. Applicants have NOT conceded that the claims at issue in the instant application are for "the same or substantially the same subject matter" as the claims of the by US 5,679,796. Second, the Office Action fails to set forth the requisite findings of fact to establish that any claim of Applicants in the instant case was not made prior to one year from the date on which the patent, US 5,679,796 was granted.
- 2) **Applicants' claims in question were made prior to one year** from the date on which US Patent 5,679,796 was granted. It is important to consider that the instant case is a US national phase application filed under §371 based on international PCT/EP96/05565 application filed on December 12, 1996. Therefore for all purposes, except considerations under §102(e), the instant national phase application should be accorded the benefit of the international filing date of December 12, 1996 (See 35 USC § 375 & PCT Art. 11(3 & 4)). The statutory bar date in view of US 5,679,796 under §135(b) is October 21, 1998 - which is one year from the grant date of the patent. Applicants' claims in the instant case obtain the benefit of the international filing date of December 12, 1996. Applicants claims where made as of the December 12, 1996 international filing date which is before October 21, 1998, and therefore were Applicants claims were made prior to one year from the date on which the patent, US 5,679,796 was granted.

Applicants respectfully submit that the present application is now in condition for allowance. A Notice of Allowance is respectfully solicited. If any fee is due in connection with this response, the Assistant Commissioner is authorized to charge Deposit Account No. 19-0134 for the appropriate amount.

Respectfully submitted,

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